

REMARKS

Claims 1-21 and 33-35 are pending in this application.

The Examiner has rejected Claims 1-3, 5-9 and 21 under 35 U.S.C. §102(b) as being anticipated by Francisco et al. U.S. Patent No. 5,308,522 (“Francisco et al.”).

On page 3 of the Office Action, the Examiner states that, in response to Applicant’s argument that Francisco does not teach a high throughput method for screening lubricating oil composition samples for compatibility with elastomers, under program control, it is the Examiner’s view that the recitations “high throughput” and “program control” have not been given any patentable weight because the recitations are in the preamble of the claim. According to the Examiner, “[a] preamble is generally not accorded any patent weight where it merely cites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone.” citing *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

It is well established that in considering whether a preamble limits a claim, the preamble is analyzed to ascertain whether it states a necessary and defining aspect of the invention, or is simply an introduction to the general field of the claim. *On Demand Machine Corp. v. Ingram Industries Inc.*, 78 USPQ2d 1428, 1436-38 (Fed. Cir. 2006). (citing *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478 (CCPA 1951) “ the court aptly described the inquiry as whether the preamble is ‘necessary to give life, meaning and vitality to the claims or counts.’ ”) The court in *On Demand Machine Corp.* held that the phrase “high speed manufacture of a single copy of a book” in the preamble of a claim directed to a system and method of manufacturing a single copy of a book in response to a customer’s request, does necessarily limit the claims in that it

states the framework of the invention, whose purpose is rapid single-copy printing of a customer's selected book. The court went on to state that:

“The high speed manufacture of a single copy is fundamental to the Ross invention, for the specification highlights that the customer may have a printed and bound copy within ‘three to five minutes.’ Col. 2, line 33. While ODMC points out that Lightning Source’s web site touts ‘In one week, we craft 70,000+ books, one at a time,’ such mass production is not the invention described and claimed by Ross.”

As is the case here, the recitation “high throughput method for screening lubricating oil composition samples for compatibility with elastomers, under program control” in Claim 1 is necessary to give life, meaning and vitality to the present claims as the purpose of the claims is to conduct a high throughput method under program control, i.e., automated, such that a relatively large number of different lubricating oil composition samples can be rapidly prepared and screened for elastomer compatibility data. This is clearly set forth in the present specification on page 4, lines 12-16, which states:

Accordingly, it would be desirable to rapidly screen a plurality of sample candidate lubricating oil compositions for compatibility with elastomers utilizing small amounts of each sample. In this manner, a high throughput preparation and screening of a vast number of diverse compositions can be achieved to identify which compositions are substantially compatible with elastomers.

and on page 6, lines 10-15, which states:

The present invention is directed to a high throughput screening method for determining the compatibility of lubricating oil compositions with elastomers. The expression “high throughput” as used herein shall be understood to mean that a relatively large number of different lubricating oil compositions can be rapidly prepared and analyzed.

Thus, the method as presently recited in Claim 1 can only be regarded as being carried out in a high throughput manner under program control. Accordingly, the recitation “high throughput method for screening lubricating oil composition samples for compatibility with elastomers, under program control” in Claim 1 must be considered when determining patentability of the claims.

In contrast to the presently claimed invention, Francisco et al. fail to disclose a *high throughput method for screening lubricating oil composition samples for compatibility with elastomers, under program control*, comprising the steps of: (a) providing a plurality of different lubricating oil composition samples, each sample comprising (i) a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive; (b) providing at least one elastomer; (c) measuring the elastomer compatibility of each sample to provide elastomer compatibility data for each sample; and, (d) outputting the results of step (c) as presently recited in Claim 1.

Rather, the invention in Francisco et al. relates to a lubricant composition containing (a) a major amount of a lubricating oil basestock and (b) a minor amount of a benzotriazole for improving the load-carrying capacity of a lubricant composition under load conditions. Francisco et al. further disclose in Example 3 testing a commercially available amine phosphate additive against compounds I and II from Example 2 for elastomer seal stability by measuring the volume and tensile strength of a silicone elastomer specimen before and after it is contacted with a test formulation containing the desired load additive. At no point is there any disclosure in Francisco et al. of rapidly preparing and analyzing a relatively large number of different lubricating oil composition samples for elastomer compatibility data in a high throughput method conducted under program control, as set forth in the present claims. Certainly, nothing in

Francisco et al., much less Example 3 of Francisco et al., even remotely discloses a high throughput method conducted under program control. Thus, Francisco et al. do not disclose all of the elements and limitations of the claimed invention. For the foregoing reasons, Claims 1-3, 5-9, and 21 are believed to be novel over Francisco et al.

Accordingly, withdrawal of the rejection of Claims 1-3, 5-9 and 21 under 35 U.S.C. §102(b) is respectfully requested.

The Examiner has rejected Claims 1, 2, 4, 5, 8 and 10-12 under 35 U.S.C. §102(b) as being anticipated by Migdal et al. U.S. Patent No. 5,062,980 (“Migdal et al.”).

On page 3 of the Office Action, the Examiner likewise states that in response to Applicant’s argument that Migdal et al. do not teach a high throughput method for screening lubricating oil composition samples for compatibility with elastomers, program control, it is the Examiner’s view that the recitations “high throughput” and “program control” have not been given any patentable weight because the recitations are in the preamble of the claim. As with Francisco et al., according to the Examiner, “[a] preamble is generally not accorded any patent weight where it merely cites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone.” Therefore, the Examiner maintains the rejection that Claims 1, 2, 4, 5, 8 and 10-12 are anticipated by Migdal et al.

It is respectfully submitted that Migdal et al. is no more an anticipatory reference than Francisco et al. Migdal et al. disclose a novel additive which improves the dispersancy and Viton® Seal compatibility of a lubricating oil. Migdal et al. further disclose in Example X individually testing lubricating oil compositions containing the additive for Viton® Seal compatibility using an AK-6 Bend Test.

As previously stated, the high throughput method, as set forth in the present claims, is conducted under program control, i.e., automated, such that a relatively large number of different lubricating oil composition samples can be rapidly prepared and screened for elastomer compatibility data. At no point is there any remote disclosure in Migdal et al., much less Example X of Migdal et al., of a high throughput method for screening a plurality of different lubricating oil composition samples for elastomer compatibility data conducted under program control. Thus, Migdal et al. do not disclose all of the elements and limitations of the claimed invention. For the foregoing reasons, Claims 1, 2, 4, 5, 8 and 10-12 are believed to clearly possess novel subject matter relative to Migdal et al. Accordingly, withdrawal of the rejection of Claims 1, 2, 4, 5, 8 and 10-12 under 35 U.S.C. §102(b) is respectfully requested.

The Examiner has rejected Claims 1-3, 5-9, 15, 16 and 21 under 35 U.S.C. §103(a) as being obvious over Francisco et al. in view of Chaffee et al. U.S. Patent No. 4,774,281 (“Chaffee et al.”).

The deficiencies of Francisco et al. discussed above with respect to the rejection of Claim 1 apply with equal force to this rejection. Chaffee et al. do not cure and is not cited as curing the deficiencies of Francisco et al. Rather, Chaffee et al. simply disclose silicone rubber compositions that are individually tested for physical properties. As such, even by combining Chaffee et al. with Francisco et al., one skilled in the art would not even arrive at the claimed high throughput method. In contrast, one would simply arrive at individually testing the silicone rubber compositions of Chaffee et al. with the lubricant composition of Francisco et al. containing (a) a major amount of a lubricating oil basestock and (b) a minor amount of a benzotriazole. For the foregoing reasons, Claims 1-3, 5-9, 15, 16 and 21 are believed to be nonobvious, and therefore patentable, over Francisco et al. and Chaffee et al. Accordingly,

withdrawal of the rejection of Claims 1-3, 5-9, 15, 16 and 21 under 35 U.S.C. §103(a) is respectfully requested.

The Examiner has rejected Claims 1-3, 5-9, 11-14, 17-21 and 33-35 under 35 U.S.C. §103(a) as being obvious over Francisco et al. in view of Kolosov et al. U.S. Patent Application Publication No. 2004/0123650 (“Kolosov et al.”).

The deficiencies of Francisco et al. discussed above with respect to the rejection of Claim 1 apply with equal force to this rejection. It is well established that there must be some teaching, motivation or suggestion to select and combine references relied upon as evidence of obviousness. As is the case here, Kolosov et al. provide no teaching, motivation or suggestion that a plurality of different lubricating oil composition samples, each sample comprising (i) a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive, can be screened for the compatibility of the compositions with elastomers under program control in a high throughput method as presently recited in Claim 1. Nor, for that matter does Kolosov et al. provide any teaching, motivation or suggestion of a combinatorial library obtained from a high throughput method for storing lubricating oil composition elastomer compatibility data on a programmed controller for a plurality of different lubricating oil compositions, as recited in present Claim 33.

According to the Examiner “one of ordinary skill in the art would have been motivated to use the computer controlled robot of Kolosov et al. with the elastomer testing protocol of Francisco et al. because of the need to reduce time in analyzing samples”. The Examiner goes on to state that “[o]ne of ordinary skill in the art would have had a reasonable expectation of success in combining the computer controlled robot of Kolosov et al. with the elastomer testing protocol of Francisco et al. because Kolosov et al. has applied the computer controlled robot

toward rheological studies (e.g., viscosity or elasticity).” Thus, the Examiner concludes that it would not be unreasonable to apply the computer controlled robot as part of the method of Francisco et al. because tensile strength is directly related to elasticity.

However, Kolosov et al. disclose in paragraph [0042] that the present invention may be used to screen or test most any *flowable* material that may be a commercial product itself or may be an ingredient or portion within a commercial product. Kolosov et al. further disclose in paragraph [0043] that the invention thus has particular utility in connection with the screening of a number of different material forms including, for example, gels, oils, solvents, greases, creams, foams and other whipped materials, ointments, pastes, powders, films, particles, bulk materials, dispersions, suspensions, emulsions or the like. In paragraph [0044] Kolosov et al. states that polymers can be employed in the method disclosed therein and goes on to state in paragraph [0048] that the polymer sample may need to be dissolved, dispersed or emulsified to form a liquid sample.

At no point is there any teaching or suggestion in Kolosov et al. of screening elastomers which are susceptible to serious deterioration from lubricating oil compositions containing (i) a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive for elastomer compatibility of each lubricating oil composition sample. In contrast, Kolosov et al. is concerned with screening or testing most any *flowable* material for rheological properties. As such, nothing in Kolosov et al. would lead one skilled in the art to look to the method for screening or testing most any flowable material for rheological properties disclosed therein to modify the manual test of Francisco et al., for testing a commercially available amine phosphate additive against compounds I and II from Example 2 for elastomer seal stability with a test formulation containing the desired load additive, and arrive

at the presently claimed invention. Accordingly, Claims 1-3, 5-9, 11-14, 17-21 and 33-35 are believed to be nonobvious, and therefore patentable, over Kolosov et al. and Francisco et al. Thus, withdrawal of the rejection is respectfully requested.

The Examiner has provisionally rejected Claims 1-3 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-4 of U.S. Patent No. 7,137,289 in view of Francisco et al. and further in view of Bailey et al. U.S. Patent No. 3,108,397 (“Bailey et al.”). Upon resolution of all outstanding issues remaining in the Office Action, Applicant will consider the timely submission of a Terminal Disclaimer.

The Examiner has provisionally rejected Claims 1-3 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-4 of co-pending U.S. Serial No. 11/528,747 in view of Bailey et al. Initially, it is noted that the Examiner’s rejection based on U.S. Serial No. 11/528,747 appears to contain a typographical error. Instead, Applicant believes that the correct U.S. Serial No. is 11/582,747 and clarification is respectfully requested. However, upon resolution of all outstanding issues remaining in the Office Action, Applicant will consider the timely submission of a Terminal Disclaimer.

The Examiner has provisionally rejected Claim 1 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 1 of co-pending U.S. Serial No. 11/699,510 in view of Francisco et al. Upon resolution of all outstanding issues remaining in the Office Action, Applicant will consider the timely submission of a Terminal Disclaimer.

The Examiner has provisionally rejected Claim 1 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 1 of co-pending U.S. Serial Nos. 11/605,127; 10/699,508; 10/699,507 and 10/779,422 in view of Francisco et al. and further in view of Guinther et al. U.S. Patent Application Publication No. 2004/0074452 (“Guinther et

al.”). Upon resolution of all outstanding issues remaining in the Office Action, Applicant will consider the timely submission of a Terminal Disclaimer.

The Examiner has rejected Claims 33-35 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement as the description of the present application does not provide for the recitation “lubricating oil composition elastomer compatibility data stored on a programmed controller” as claimed. Specifically, it is the Examiner's belief that paragraph [0071] of the published application which states that “elastomer compatibility is programmed into the computer controller for "pass/fail" determination” is considerably more narrow (i.e., merely compatible or incompatible) than generically storing elastomer compatibility data, which reads on a broad range of numerical values.

Applicant's submit that the recitation “lubricating oil composition elastomer compatibility data stored on a programmed controller” as claimed is fully described in the specification. It is well established that “[t]he test for sufficiency of support ... is whether the disclosure of the application relied upon ‘reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.’” *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 USPQ 2d 1111, 1116 (Fed. Cir. 1991) quoting *Ralston Purina Co. v. Far-Mar-Co. Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985). Exactly how the specification allows one skilled in the art to recognize that an applicant had possession of the claimed invention is not material. *In re Smith*, 481 F.2d 910, 178 USPQ 279 (CCPA 1973). What is required is that an ordinarily skilled artisan recognizes from the disclosure that applicants invented the subject matter of the claims, including the limitations recited therein. *In re Smith*, 481 F.2d at 915, 178 USPQ at 284.

The specification would clearly allow one skilled in the art to understand the claimed recitation "lubricating oil composition elastomer compatibility data stored on a programmed controller." First, the specification sets forth on page 6, line 21 through page 7, line 10 that:

Data regarding the composition of each sample are stored in a data library. Adding the information related to the elastomer compatibility data of each of the stored compositions substantially facilitates the selection of candidate compositions capable of successfully carrying out the elastomer compatibility tests under the desired operating conditions or statutory requirements. Accordingly, storing this information in the combinatorial library not only allows for a rapid selection of multiple lubricating oil compositions in response to new requirements for a given test, but also becomes another piece of information in addition to, for example, storage stability, oxidation stability, wear stability, dispersancy data, deposit formation data, etc., of the catalogued compositions. This information may also allow for calculating necessary changes of the additives at the least cost. The procedure is advantageously accomplished under program control and automatically controlled by, for example, a microprocessor or other computer control device.

Second, the specification further sets forth on page 23, lines 7-10 that:

Testing station 220 includes means for testing the samples for the compatibility with an elastomer. *Elastomer compatibility data results of the test are converted to an electrical or optical signal and transmitted via signal transmission line 223 to computer controller 230.* [Emphasis added]

Finally, the specification sets forth on page 26, lines 7-12 that :

Elastomer compatibility data regarding each of the compositions described herein can be stored in a relational database to provide a combinatorial lubricating oil composition library. Alternatively, the system may be electrically connected to a signal data collector comprising a computer microprocessor for system operation and control to collect the data from the various tests over an extended period of time to compile the combinatorial lubricating oil composition library.

As such, it is clear that all lubricating oil composition elastomer compatibility data is stored on a programmed controller. Thus, the recitation “lubricating oil composition elastomer compatibility data stored on a programmed controller” as claimed can be found within the specification as filed to allow one skilled in the art to believe that applicants were in possession of the claimed subject matter as of the filing date. Such being the case, the claimed “lubricating oil composition elastomer compatibility data stored on a programmed controller” as presently recited in Claims 33-35 is believed to be fully supported as to comply with the requirement for the first paragraph of 35 U.S.C. §112.

For the foregoing reasons, Claims 1-21 and 33-35 as presented herein are believed to be in condition for allowance. Such early and favorable action is earnestly solicited.

Respectfully submitted,



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